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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,768	12/06/2001	Kevin P. Baker	GNE.2830P1C10	1346
30313	7590	01/21/2004	EXAMINER	
KNOBBE, MARTENS, OLSON & BEAR, LLP			KAPUST, RACHEL B	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1647	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,768

Applicant(s)

BAKER ET AL.

Examiner

Rachel B. Kapust

Art Unit

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-- *Th MAILING DATE of this communication appears on the cov r sheet with the correspondenc address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Priority

According to the priority statement of September 9, 2002, the claimed subject matter defined in the instant application is supported by parent application serial nos. 60/100848, 09/403297, 09/946374, PCT/US99/20111, and PCT/US00/04342. Based on the information given by applicant and an inspection of the patent applications, the examiner has concluded that the subject matter defined in this application is supported by the disclosure in application serial no. PCT/US00/04342, filed February 18, 2000 but is not supported by any of the earlier applications because no utility for the polypeptide PRO 1412 is disclosed in the earlier applications. The results of the chondrocyte proliferation assay and the fetal hemoglobin induction in erythroblastic cell line assays are first reported in PCT/US00/04342. Accordingly, the subject matter defined in claims 28-33 has an effective filing date of February 18, 2000.

Should the Applicant disagree with the examiner's factual determination above, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to February 18, 2000 that specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of and fully enabled prior to February 18, 2000.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is drawn to an antibody that specifically binds to a polypeptide comprising SEQ ID NO: 140 (PRO1412). The term "specifically binds" is a relative term which renders the claims indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one skilled in the art would not be reasonably

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apprised of the scope of the invention. It is unclear what amount of binding would be considered to be "specific". One skilled in the art would not know what the metes and bounds of specific binding are.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 28-33 are rejected under 35 U.S.C. 102(a) as being anticipated by International Patent Application Publication No. WO 00/00610 (Lal *et al.*, publication date January 6, 2000). These claims encompass antibodies that bind to a polypeptide comprising SEQ ID NO: 140. WO 00/00610 teaches SEQ ID NO: 24, which encodes a polypeptide that is 99.3% identical to SEQ ID NO: 140 (see attached alignment of SEQ ID NO: 24 from WO 00/00610 and SEQ ID NO: 140 of the current application). WO 00/00610 further teaches monoclonal antibodies, antibody fragments, humanized antibodies, and labeled antibodies (pages 45 and 52). A person of ordinary skill in the art would expect that the antibodies as taught in WO 00/00610 would bind to the polypeptide comprising SEQ ID NO: 140.

Conclusion


NO CLAIMS ARE ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel B. Kapust whose telephone number is (703) 305-0634. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm. Please note for your records that as of January 20, 2004, the examiner's new telephone number will be (571) 272-0886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (703) 308-4623. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

RBK
1/19/04


JANET ANDRES
PATENT EXAMINER